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### REMARKS

This response is intended as a full and complete response to the non-final Office Action mailed September 20, 2006. In the Office Action, the Examiner notes that claims 1-25 are pending and rejected.

In view of the following discussion, Applicant submits that none of the claims now pending in the application are obvious under the provisions of 35 U.S.C. §103. Thus, Applicant believes that all of the claims are now in allowable form.

It is to be understood that Applicant does not acquiesce to the Examiner's characterizations of the art of record or to Applicant's subject matter recited in the pending claims. Further, Applicant is not acquiescing to the Examiner's statements as to the applicability of the prior art of record to the pending claims by filing the instant response.

### 35 U.S.C. §103 Rejection of Claims 1-7

The Examiner has rejected claims 1-7 under 35 U.S.C. §103(a) as being unpatentable over Goldstein U.S. Patent 5,410,326 (hereinafter "Goldstein") in view of Seth-Smith et al. U.S. Patent 4,890,321 (hereinafter "Seth-Smith"). Applicant respectfully traverses the rejection.

Claim 1 recites:

1. A set top terminal for generating an interactive electronic program guide for display on a television connected thereto, the terminal comprising:
  - means for retrieving information about a subscriber;
  - means for receiving a television signal;
  - means for extracting individual programs from the television signal;
  - means to demultiplex video, audio, graphics and text;
  - means to separately access the audio while a program extract from the television signal is being displayed;
  - means for generating an electronic program guide for controlling display of content on a television screen, the guide comprising a plurality of menus including:
    - a home menu;
    - a plurality of major menus displayed as menu options on the home menu;
    - a plurality of sub-menus displayed as menu options on the plurality of major menus; and

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a plurality of during programming menus enacted after selection of a program,  
wherein at least one of the plurality of menus comprises the demultiplexed video, graphics and text, and wherein at least one of the plurality of major menus comprises displaying a plurality of audio choices for accessing the audio; and  
means for receiving the selection signals from a user input.  
(emphasis added).

The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 USPQ 1021, 1024 (Fed. Cir. 1984) (emphasis added). Moreover, the invention as a whole is not restricted to the specific subject matter claimed, but also embraces its properties and the problem it solves. In re Wright, 6 USPQ 2d 1959, 1961 (Fed. Cir. 1988) (emphasis added). The Goldstein and Seth-Smith references alone or in combination fail to teach or suggest Applicant's invention as a whole.

Specifically, Goldstein fails to teach or suggest at least "means to demultiplex video, audio, graphics and text", "means to separately access the audio while a program extract from the television signal is being displayed;" and "wherein at least one of the plurality of major menus comprises displaying a plurality of audio choices for accessing the audio;" as recited in independent claim 1 as amended.

Goldstein discloses a "universal remote control device which is programmed to operate a variety of consumer products" (Abstract). However, Goldstein does not teach or suggest a means to demultiplex video, audio, graphics and text. The Examiner generally cites FIG. 14 and column 16, line 38 – column 19, line 12 of Goldstein. However, nowhere in the cited passage does Goldstein teach a means to demultiplex video, audio, graphics and text. Notably, FIG. 14 of Goldstein fails to illustrate any device that could even perform the functions of a demultiplexer.

Moreover, Goldstein fails to teach or to suggest a means to separately access demultiplexed audio, or that at least one menu comprises displaying the audio choices for selection. However, the Examiner alleges that Seth-Smith bridges the substantial gap left by Goldstein and the Applicant's invention.

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Seth-Smith fails to bridge the substantial gap between Goldstein and the Applicant's invention. Seth-Smith fails to teach or to suggest means to demultiplex video, audio, graphics and text. In particular, Seth-Smith discloses a teletext message is assembled with video and multi-channel audio before being transmitted to a subscriber. (See Seth-Smith, col. 6, ll. 43-52, FIG. 1) Notably, the signal is never disassembled after transmission. In fact, Seth-Smith teaches that the format of the signal is a single frame. (See *Id.* at col. 7, ll. 29-67, FIG. 2) Therefore, Seth-Smith teaches away from the Applicant's invention of means to demultiplex video, audio, graphics and text.

Furthermore, Seth-Smith fails to teach or suggest means to separately access the audio while a program extract from the television signal is being displayed. Seth-Smith clearly teaches that the audio channels are associated with the program (i.e., one of the audio channels is played with the program). (See Seth-Smith, col. 14, ll. 5-18, emphasis added) Therefore, again Seth-Smith teaches away from the Applicant's invention because unlike the Applicant's invention, Seth-Smith is incapable of separately accessing the audio while a program extract from the television signal is being displayed.

Finally, Seth-Smith also fails to teach or suggest that at least one menu comprises displaying the audio choices for selection. Seth-Smith generally teaches the use of menus to implement a "tier" concept, such as program tiers. (See Seth-Smith, col. 32, ll. 9-63) Notably, Seth-Smith does not specifically teach that the menus comprise displaying the audio choices for selection because Seth-Smith teaches that the audio channels are associated with a program, as discussed above. (See Seth-Smith, col. 14, ll. 5-18, emphasis added)

As such, claim 1 is patentable over Goldstein in view of Seth-Smith under 35 U.S.C. §103(a). Furthermore, claims 2-7 depend, directly or indirectly, from independent claim 1, while adding additional elements. Therefore, claims 2-7 are also patentable over Goldstein in view of Seth-Smith under §103 for at least the same reasons that claim 1 is patentable over Goldstein in view of Seth-Smith under §103.

Therefore, Applicant respectfully requests that the Examiner's rejection be withdrawn.

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### **35 U.S.C. §103 Rejection of Claims 22 and 23**

The Examiner has rejected claims 22 and 23 under 35 U.S.C. §103(a) as being unpatentable over Banker et al. (U.S. Patent 5,477,262, hereinafter "Banker") in view of Seth-Smith.

Claim 22 recites:

22. A set top terminal for generating an interactive electronic program guide for display on a television connected to the set top terminal, the terminal comprising:  
means for retrieving information about a subscriber;  
means for receiving a television signal;  
means for extracting individual programs from the television signal;  
means to demultiplex video, audio, graphics and text;  
means to separately access the audio while a program extract from the television signal is being displayed;  
means for generating an electronic program guide for controlling display of content on a television screen, the guide comprising a plurality of menus including:  
a plurality of interactive menus, each corresponding to a level of interactivity and having one or more interactive menu items for selection; and  
a main menu having one or more main menu items for selection, which main menu items correspond to the interactive menus, wherein the menus are navigated using a user input, and wherein the main menu items and the interactive menu items are responsive to selection signals received from the user input,  
wherein at least one of the plurality of menus comprises the demultiplexed video, graphics and text, and wherein at least one of the plurality of menus comprises displaying a plurality of audio choices for accessing the audio; and  
means for receiving the selection signals from the user input.  
(emphasis added).

The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 USPQ 1021, 1024 (Fed. Cir. 1984) (emphasis added). Moreover, the invention as a whole is not restricted to the specific subject matter claimed, but also embraces its properties and the problem it solves. In re Wright, 6 USPQ 2d 1959, 1961 (Fed. Cir.

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1988) (emphasis added). The Goldstein and Seth-Smith references alone or in combination fail to teach or suggest Applicant's invention as a whole.

Specifically, Banker fails to teach or suggest at least "means to demultiplex video, audio, graphics and text", "means to separately access the audio while a program extract from the television signal is being displayed;" and "wherein at least one of the plurality of major menus comprises displaying a plurality of audio choices for accessing the audio;" as recited in independent claim 1 as amended.

Banker discloses an "[a]pparatus for providing a user friendly interface to a subscription television terminal comprises a key pad arranged into a plurality of key groupings and an on-screen display controller for generating a plurality of screens for display on an associated television receiver" (abstract). However, nowhere in the cited passage does Banker teach a means to demultiplex video, audio, graphics and text. Notably, Banker fails to illustrate any device that could even perform the functions of a demultiplexer.

Moreover, Banker fails to teach or to suggest a means to separately access demultiplexed audio, or that at least one menu comprises displaying the audio choices for selection. However, the Examiner alleges that Seth-Smith bridges the substantial gap left by Banker and the Applicant's invention.

Seth-Smith fails to bridge the substantial gap between Banker and the Applicant's invention. Seth-Smith fails to teach or to suggest means to demultiplex video, audio, graphics and text. In particular, Seth-Smith discloses a teletext message is assembled with video and multi-channel audio before being transmitted to a subscriber. (See Seth-Smith, col. 6, ll. 43-52, FIG. 1) Notably, the signal is never disassembled after transmission. In fact, Seth-Smith teaches that the format of the signal is a single frame. (See *Id.* at col. 7, ll. 29-67, FIG. 2) Therefore, Seth-Smith teaches away from the Applicant's invention of means to demultiplex video, audio, graphics and text.

Furthermore, Seth-Smith fails to teach or suggest means to separately access the audio while a program extract from the television signal is being displayed. Seth-Smith clearly teaches that the audio channels are associated with the program (i.e., one of the audio channels is played with the program). (See Seth-Smith, col. 14, ll. 5-18,

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emphasis added) Therefore, again Seth-Smith teaches away from the Applicant's invention because unlike the Applicant's invention, Seth-Smith is incapable of separately accessing the audio while a program extract from the television signal is being displayed.

Finally, Seth-Smith also fails to teach or suggest that at least one menu comprises displaying the audio choices for selection. Seth-Smith generally teaches the use of menus to implement a "tier" concept, such as program tiers. (See Seth-Smith, col. 32, ll. 9-63) Notably, Seth-Smith does not specifically teach that the menus comprise displaying the audio choices for selection because Seth-Smith teaches that the audio channels are associated with a program, as discussed above. (See Seth-Smith, col. 14, ll. 5-18, emphasis added)

As such, claim 22 is patentable over Banker in view of Seth-Smith. Claim 23 recites relevant limitations similar to those recited in claim 22 and, accordingly, for at least the same reasons discussed above with respect to claim 22, claim 23 also is patentable over Banker in view of Seth-Smith.

Therefore, Applicant respectfully requests that the Examiner's rejection be withdrawn.

### **35 U.S.C. §103 Rejection of Claims 8-21**

The Examiner has rejected claims 8-21 under 35 U.S.C. §103(a) as being unpatentable over Banker in view of Seth-Smith and U.S. Patent 5,539,871 to Gibson (hereinafter "Gibson"). Applicant respectfully traverses the rejection.

Claim 8 recites:

8. A set top terminal for generating an interactive electronic program guide for display on a television connected to the set top terminal, the terminal comprising:
  - means for receiving a television signal;
  - means for extracting individual programs from the television signal;
  - means to demultiplex video, audio, graphics and text;
  - means to separately access the audio while a program extract from the television signal is being displayed;
  - means for generating an electronic program guide for controlling display of content on a television screen, the guide comprising:
    - a plurality of menus, wherein at least one of the menus

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comprises the demultiplexed video, graphics and text, and wherein at least one of the menus comprises displaying a plurality of audio choices for accessing the audio;

a logo that is displayed on the television screen during one of the programs, which program has one or more interactive features; and

an overlay menu that is displayed during the one of the programs, the overlay menu including the interactive features; and

means for receiving selection signals from a user input,

wherein the logo indicates to a user that the interactive features are available for the program, and wherein the overlay menu is displayed in response to a signal received from the user input. (emphasis added).

Banker and Gibson, alone or in combination, fail to teach or suggest Applicant's invention as a whole. Specifically, Banker and Gibson fail to teach or suggest at least "means to demultiplex video, audio, graphics and text", "means to separately access the audio while a program extract from the television signal is being displayed;" and an electronic program guide comprising "a plurality of menus... wherein at least one of the plurality of menus comprises displaying a plurality of audio choices for accessing the audio" as recited in claim 8 as amended.

Banker discloses overlaying characters on a video pattern. However, Banker does not teach or suggest means to demultiplex video, audio, graphics and text, separately accessing demultiplexed audio, and that at least one menu comprises displaying the audio choices for selection.

Gibson discloses a "method and system in a data processing system for selectively associating stored data with an animated element within a multimedia presentation in a data processing system" (abstract). Gibson also does not teach or suggest means to demultiplex video, audio, graphics and text, separately access demultiplexed audio and that at least one menu comprises displaying the audio choices for selection

The Seth-Smith reference fails to bridge the substantial gap between Banker and Gibson and the Applicant's invention. Seth-Smith fails to teach or to suggest means to demultiplex video, audio, graphics and text. In particular, Seth-Smith discloses a teletext message is assembled with video and multi-channel audio before being transmitted to a subscriber. (See Seth-Smith, col. 6, ll. 43-52, FIG. 1) Notably, the signal is never dis-assembled after transmission. In fact, Seth-Smith teaches that the

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format of the signal is a single frame. (See *Id.* at col. 7, ll. 29-67, FIG. 2) Therefore, Seth-Smith teaches away from the Applicant's invention of means to demultiplex video, audio, graphics and text.

Furthermore, Seth-Smith fails to teach or suggest means to separately access the audio while a program extract from the television signal is being displayed. Seth-Smith clearly teaches that the audio channels are associated with the program (i.e., one of the audio channels is played with the program). (See Seth-Smith, col. 14, ll. 5-18, emphasis added) Therefore, again Seth-Smith teaches away from the Applicant's invention because unlike the Applicant's invention, Seth-Smith is incapable of separately accessing the audio while a program extract from the television signal is being displayed.

Finally, Seth-Smith also fails to teach or suggest that at least one menu comprises displaying the audio choices for selection. Seth-Smith generally teaches the use of menus to implement a "tier" concept, such as program tiers. (See Seth-Smith, col. 32, ll. 9-63) Notably, Seth-Smith does not specifically teach that the menus comprise displaying the audio choices for selection because Seth-Smith teaches that the audio channels are associated with a program, as discussed above. (See Seth-Smith, col. 14, ll. 5-18, emphasis added)

Thus, Banker, Seth-Smith and Gibson fail to teach or suggest the Applicant's claimed invention as a whole. As such, Applicant's independent claim 8 is patentable under 35 U.S.C. §103(a) over Banker in view of Seth-Smith and Gibson. Furthermore, claims 9-21 depend, directly or indirectly from independent claims 8 and 23, while adding additional elements. Therefore, claims 9-21 are also patentable over Banker in view of Seth-Smith and Gibson under 35 U.S.C. §103(a).

Therefore, Applicant respectfully requests that the Examiner's rejection of claims 8-21, 24 and 25 under 35 U.S.C. §103(a) be withdrawn.

### **35 U.S.C. §103 Rejection of Claims 24 and 25**

The Examiner has rejected claims 24 and 25 under 35 U.S.C. §103(a) as being unpatentable over Banker and Seth-Smith, as applied to claim 23 above, and further in view of Gibson. Applicant respectfully traverses the rejection.

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Each of the grounds of rejection applies only to dependent claims, and each is predicated on the validity of the rejection under 35 U.S.C. §103 for the corresponding independent claims. Since the rejection of the corresponding independent claims under 35 U.S.C. §103 has been overcome, as described hereinabove, and there is no argument put forth by the Office that any other additional references supply that which is missing from Banker and Seth-Smith to render the independent claims unpatentable, these grounds of rejection cannot be maintained.

Therefore, Applicant respectfully requests that the Examiner's rejection of claims 2-6 under U.S.C. §103(a) be withdrawn.

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**CONCLUSION**

Thus, Applicant submits that all of the claims presently in the application are allowable. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall or Jimmy Kim at (732) 530-9404, so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

Dated: 12/19/06

  
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